

REMARKS

Claims 21 to 27 are added, and claims 11 to 24 are therefore now pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant thanks the Examiner for acknowledging the claim for foreign priority and for indicating that all of the certified copies of the priority documents have been received.

Applicant respectfully requests that the Examiner acknowledge acceptance of the drawings.

Claims 11 to 20 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application No. 2004/0114381 (“Salmeen” reference).

As regards to the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. *See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

As further regards of the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” M.P.E.P. § 2112; *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claims 11 and 19 have been rewritten.

While the rejections may not be agreed with, to facilitate matters, claim 11 is rewritten so that it is to a *method for improving a visibility in a motor vehicle, including: illuminating an area by at least one light source of the motor vehicle through a first optical apparatus; producing a sensor signal by at least one infrared sensor of the motor vehicle, the sensor signal coupled through a second optical apparatus; comparing the sensor signal to a source signal supplied by an amplifier, the sensor signal and the source signal being compared in a comparator, in which a greater value for the sensor signals indicates a person is situated in the area illuminated by the light source; and controlling the light source dependent on the sensor signal, in which the light source is shut off by a corresponding signal sent by the comparator to an actuated switching element.*

Thus, claim 11, as presented, provides that the illumination of an area by the at least one light source was coupled through a *first optical apparatus*, such as a lens, *and* that the sensor signal is *also coupled through a second optical apparatus from the infrared sensor*. The Salmeen reference does not disclose or suggest a system in which *both* a first optical apparatus is used to radiate the light beam from the light source to illuminate an area *and* a second optical apparatus is used to couple the sensor signal from the infrared sensor as is in the presently claimed subject matter (Substitute Specification, page 5, lns. 3-11).

Claim 11 further provides that the sensor signal is sent to *a comparator which compares the sensor signal with a source signal* that is supplied by an amplifier, and if the value of the sensor signal is greater than that of the source signal, then a person in the area illuminated by a light source and a corresponding signal is sent from the comparator to a switching element that is actuated to turn off the light source. These features are disclosed at page 6, lns. 12-18, of the Substitute Specification. From a plain reading of the Salmeen reference, it is plain that Salmeen does not disclose or suggest any of these additional features, including, in particular, an amplifier that sends out an initial source signal, or a *comparator, that compares the source and sensor signals and generates a corresponding signal sent through an switching element to shut off the light source.*

For the foregoing reasons, claim 11, as presented, is allowable, as are its dependent claims 12 to 18.

Claim 19, as presented, relates to a device for improving a visibility in a motor vehicle, and it includes feature like that of claim 11, as presented. Accordingly, claim 19, as presented, is allowable for essentially the same reasons as claim 11, as is its dependent claim 20.

Best Available Copy

Application Serial No. 10/593,144
Attorney Docket No. 10191/4466
Reply to Office Action of April 2, 2009

New claims 21 to 27 do not add any new matter and are supported by the present application. Claim 21 depends from claim 19, as presented, and is therefore allowable for the same reasons. Claims 22 to 27 depend from claim 11, as presented, and are therefore allowable for the same reasons.

Accordingly, claims 11 to 27 are allowable.

CONCLUSION

In view of the above, it is respectfully submitted that all of presently pending claims 11 to 27 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Date: 6/25/2009

Respectfully submitted,

By:

Gerard A. Messina
(Reg. No. 35,952)

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646